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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/327,266	06/07/1999	ROE-HOAN YOON	MCT-2	5252

7590 12/18/2002

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EXAMINER

HRUSKOCI, PETER A

ART UNIT

PAPER NUMBER

1724

26

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	Application N .	Applicant(s)
	09/327,266	YOON, ROE-HOAN
	Examiner Peter-A. Hruskoci	Art Unit 1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 December 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,8,10-15 and 67-73 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,8,10-15 and 67-73 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 25.

6) Other: \_\_\_\_\_

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1. Claims 12, 72, and 73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 12 “biodiesel...oils”, in claim 72 “biodiesel”, and in claim 73 “carbon...eight” lack clear antecedent basis in the specification as originally filed, and appear to be drawn to new matter.

2. Claims 1, 11, and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 “high” is vague and indefinite because it is unclear how this term further limits the claim. In claims 11 and 69 “the low HLB surfactant” lacks clear antecedent basis.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 2, 8, 10, 11, 13-15, 67-69, and 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon et al. 5,670,056 in view of Yoon et al. 5,161,694. Yoon et al. (056) disclose (see col. 2 line 21 through col. 6 line 32) a process for dewatering a slurry of fine particulate material substantially as claimed. It is submitted that the addition of a combination of non-ionic surfactants and hydrophobic polymers as disclosed in Yoon et al. (056) would appear to increase the hydrophobicity of the particulate material as in the instant process. The claims differ from Yoon et al. (056) by reciting specific steps for increasing the hydrophobicity of the particulate material with a surfactant and a hydrocarbon oil, respectively. Yoon et al. (694) disclose (see col. 13 lines 21-40, and col. 17 lines 3-49) that it is known in the art to add surfactants to mixtures of non-hydrophobic material to render the material hydrophobic, and to add hydrocarbon oil to slurries of hydrophobic material to aid in coagulating the material. It would have been obvious to one skilled in the art to modify the process of Yoon et al. (056) by addition of the recited surfactant and hydrocarbon oil in view of the teachings of Yoon et al. (694) to increase the hydrophobicity of the particulate material and aid coagulating the material in the slurry. With regard to claim 67, it is submitted that the coal dewatered in Yoon et al. (056) and (694) appears to be hydrophobic. The specific HLB of the surfactant utilized would have been considered an obvious matter of

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process optimization to one skilled in the art, depending on the specific slurry dewatered and results desired, absent a sufficient showing of unexpected results.

5. Claims 12 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon et al. (056) in view of Yoon et al. (694) as applied above, and further in view of Wang et al. 4,210,531. The claims differ from the references as applied above by reciting that the surfactant is blended with a specific oil. Wang et al. disclose (see col. 2 line 27 through col. 4 line 24) that it is known in the art to utilize a combination of surfactant and the recited oils, to aid in dewatering mineral slurry concentrates. It would have been obvious to one skilled in the art to modify the process of Yoon et al. by utilizing a surfactant blended with the recited oils in view of the teachings of Wang et al., to aid in dewatering the slurry.

6. Applicant argues that the combination of a nonionic surfactant with a hydrophobic polymer as in Yoon et al. 5,670,056 is a combination of two nonionic surfactants which clearly teaches away from the two-step hydrophobization as recited in the instant claims. It is submitted that the addition of a nonionic surfactant in the first hydrophobizing is not excluded from the instant claims. Furthermore, applicant has not presented sufficient factual evidence to support the above argument.

7. Applicant argues that the nonionic low HLB surfactant required by claim 1 is hydrophobic, and therefore substantially water insoluble, and the reagent used in Yoon et

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al. must be water soluble or water dispersible. It is submitted that the nonionic surfactant recited in claim 1 is considered patentably indistinguishable from the low HLB nonionic surfactants disclosed in Yoon et al.(056)

8. Applicant alleges that the two-step hydrophobization produces benefits and advantages over the method of Yoon et al. (056) as shown in Examples 19 and 20. These Examples have been carefully considered but fail to overcome the above rejections. It is submitted that the specific test conditions utilized to produce the results shown in these Examples are not commensurate with the scope of the instant claims. It is noted that these conditions included the use of specific surfactants in the dewatering of specific slurries. Furthermore, these Examples fail to include comparative evidence with the prior art used in the above rejections to support the above allegation.

9. Applicant argues that Yoon et al. fails to teach or suggest, either explicitly or implicitly the two-step hydrophobization as required by instant claims 1 and 67. It is submitted that the addition of a combination of non-ionic surfactants and hydrophobic polymers as disclosed in Yoon et al. would appear to increase the hydrophobicity of the particulate material as in the instant process. Furthermore, Yoon et al. (694) was applied above to teach that it is known in the art to add surfactants to mixtures of non-hydrophobic material to render the material hydrophobic, and to add hydrocarbon oil to slurries of hydrophobic material to aid in coagulating the material.

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10. Applicants arguments concerning Wang et al. are based on the propriety of Yoon et al. (056), which is deemed properly applied for reasons stated above.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (703) 308-3839. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Simmons, can be reached on (703) 308-1972. The fax phone number for this Group is (703) 872-9310 (non-after finals) and 703-872-9311 after finals.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
**Peter A. Hruskoci**  
**Primary Examiner**  
**Art Unit 1724**

P. Hruskoci  
December 16, 2002